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10/752,879	01/06/2004	Peter R. Brownell	P06605US00	4552
22885	7590	12/07/2006	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			O'CONNOR, GERALD J	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20061127

Application Number: 10/752,879
Filing Date: January 6, 2004
Appellant(s): Brownell

John D. Goodhue
(Reg. No. 47,603)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal
filed September 12, 2006.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(Sole inventor of record, *Peter Brownell*, and *Brownells, Inc.*)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(None.)

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(Claims 1-21 are pending, rejected, and appealed.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(No after-final amendments have been filed.)

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is substantially correct:

- I. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uemura (US 2001/0027429).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

US 2001/0027429	Uemura	10/2001
Official Notice	That firearm products (guns, guns parts, ammunition, etc.) comprise products that are sold.	
Official Notice	That sales of certain firearm products (e.g., silencers, fully-automatic weapons/kits/components, etc.) are restricted to certain authorized (i.e., properly licensed) persons or organizations (e.g., police, military, etc.).	

(9) *Grounds of Rejection*

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uemura (US 2001/0027429).

Uemura discloses a method of selling replacement parts for a product to a customer and over a computer network, comprising: providing a plurality of product selections for the customer to select from over the computer network; receiving a product selection of one of the products from the customer over the computer network; providing over the computer network and to the customer an interactive schematic illustrating a plurality of component parts of the product with associated reference identifiers over the computer network; and, receiving a selection from the interactive schematic of at least one of the component parts over the computer network, but Uemura does not disclose providing a plurality of product manufacturer selection options for a customer to select from over the computer network and receiving a manufacturer selection of one of the product manufacturers over the computer network, as the website of Uemura is for a single manufacturer. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Uemura so as to allow the customer to select a product manufacturer from a plurality of product manufacturer options over the computer network, rather than being limited to only ordering parts for products of a single manufacturer, since it is well settled that mere duplication of the essential working parts of a device involves only routine skill in the art. In re Harza, 124 USPQ 378 (CCPA 1960). See MPEP § 2144.04(VI)(B).

Regarding claims 2, 9, and 14, the method of Uemura further comprises providing a description of the component part selected, including at least one name for the component part and at least one manufacturer part number for the component part.

Regarding claims 3, 8, 19, and 20, the functionality of Uemura is effected/implemented by means of a website for the customer to visit, but the product of the method of Uemura is not a firearm product. However, sales of firearm products are well known, hence obvious, to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have adapted the method of Uemura to instead sell firearm products, as is well known to do, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, merely as a matter of design choice.

Regarding claims 4, 5, 16, 17, and 21, the reference identifier in the method of Uemura is a selectable reference numeral, and the schematic in the method of Uemura is an exploded view.

Regarding claims 6 and 12, the method of Uemura further comprises receiving an order for the component part from the customer.

Regarding claims 7, 13, and 15, the description in the method of Uemura includes only one name and one part number associated with each component part. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Uemura so as to have had more than one name/part number associated with each

component part, since it is well settled that the mere duplication of the essential working parts of a device involves only routine skill in the art. In re Harza, 124 USPQ 378 (CCPA 1960). See MPEP § 2144.04(VI)(B).

Regarding claims 10 and 11, the components sold in the method of Uemura are not restricted, so no special authorization is required. However, restricting sales of certain gun components (e.g., silencers, full-auto kits/components, etc.) to be sold only to authorized (i.e., licensed) persons is well known, hence obvious, to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of Uemura so as to sell restricted gun components, but to sell the restricted components only to properly authorized persons, as is well known to do, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, merely as a matter of design choice.

Regarding claim 18, the reference identifiers in the method of Uemura are not listed in alphabetical order according to the part names. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Uemura so as to list the reference identifiers in alphabetical order according to part names, merely as a matter of arbitrary design choice, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

(10) Response to Argument

I. Claims 1-21 are unpatentable under 35 U.S.C. 103(a) for being obvious over Uemura (US 2001/0027429).

A. Regarding the argument that Uemura is directed to solving a different problem than the problem faced by appellant, the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

B1. Regarding the argument that Uemura does not disclose that the schematic is interactive by means of a selectable link on the schematic to select to receive an associated description of the selected part, Uemura indeed discloses that the schematic is interactive by means of a selectable link on the schematic to select to receive an associated description of the selected part. See, in particular, ¶ 42 and ¶ 43.

B2. Regarding the argument that providing for sales of parts by multiple manufacturers instead of providing for sales of parts by a single manufacturer involves more than mere duplication of the essential working parts of the device of Uemura, such a functional modification does not involve more than mere duplication of the essential working parts of the device of Uemura.

B3. Regarding the argument that changing the particular non-functional descriptive material used to identify/describe the various parts for sale should be sufficient to render appellant's invention patentably distinct over the invention of Uemura, mere changes alone in printed matter or other non-functional descriptive material are insufficient to impart patentability to an otherwise unpatentable invention.

B4. Regarding the argument that appellant's intended use (sales of guns/firearms) is different from the intended use of Uemura (sales of other products), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

B5. Regarding the argument that appellant's intended use (sales limited to only those sales comprising legal sales, in compliance with the law) is different from the intended use of Uemura (sales of unrestricted products to anybody), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

B6. Regarding the argument that Uemura does not disclose that the parts diagram is provided over the computer network, Uemura indeed discloses that the parts diagram is provided over the computer network 7. See, in particular, Figure 1.


B7. Regarding the argument that Uemura does not disclose providing a website for the customer to visit to order the part, Uemura indeed discloses providing a website for the customer to visit to order the part. See, in particular, ¶ 36.

(11) *Related Proceeding(s) Appendix*

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For all of the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


 11/27/06
Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

GJOC

November 27, 2006

Appeal Conference Held:


Alex Kalinowski
Supervisory Patent Examiner
Group Art Unit 3627


Sam Sough
Supervisory Patent Examiner
Appeal Conference Specialist
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